

REMARKS

Applicant replies to the Office Action dated May 8, 2009 within the shortened statutory one month time period. Claims 1-123, 158 and 159 remain pending. No new matter has been added to the application in the previous amendments to the claims. Reconsideration of this application in view of the Remarks that follow is respectfully requested.

Summary of Telephonic Interviews

As an initial matter, Applicant thanks the Examiner for the interviews conducted on May 13, 2008 with Applicant's attorneys Howard Sobelman (U.S. Patent Reg. No. 39,038) and Jamie Sullivan (U.S. Patent Reg. No. 59,165). In the interview, the Examiner consented to Applicant including the Examiner's requested formatting changes to the previously submitted claims, as part of the Reply submitted herein. The Examiner also agreed that Applicant can submit a Reply to this Office Action without re-submitting the corrected Replies, as submitted in reply to the last Office Action dated November 5, 2008.

Amendments to the Claims

Applicant clarifies the previous amendments to the claims in this Reply to comply with procedures set forth in 37 CFR 1.121 and 37 CFR 1.173. *See also*, MPEP § 1453. 37 CFR 1.121 provides that "any amendment to the . . . claims in reissue applications must be made in accordance with § 1.173." Pursuant to 37 CFR 1.173(d)(1), where an amendment is made in a reissue application by separate amendment paper to omit matter from a claim, "the matter to be omitted by reissue must be enclosed in brackets." *Id.* The matter previously omitted by reissue in the above pending claims has been shown in brackets. Pursuant to 37 CFR 1.173(d)(2), where an amendment is made in a reissue application by separate amendment paper to add matter to a claim, "the matter to be added by reissue must be underlined." *Id.* The matter previously added by reissue in the above pending claims has been underlined. Finally, 37 CFR 1.173(b)(2) provides that "for any claim changed by the amendment paper, a parenthetical expression 'amended,' 'twice amended,' etc., should follow the claim number. As such, where pending claims

have been previously amended above throughout prosecution and during reissue, the appropriate parenthetical expression has been included after the claim number. *Id.*

Claim Rejections – 35 USC § 251

The Examiner next rejects claims 71-123 under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent, upon which the present reissue is based. Specifically, with respect to independent claim 71, the Examiner contends that Applicant deleted, removed or omitted the limitation of “applying the solution as the travel scheme for minimizing travel costs by purchasing travel trips in accordance with the solution” (hereinafter referred to as the “Claim Limitation”). The Examiner contends the Claim Limitation is surrendered subject matter. Claims 72-123 stand rejected as being dependent upon independent claim 71. For the reasons provided below, Applicant respectfully disagrees and traverses.

As an initial matter, and by way of background, the Claim Limitation was added to claims 1 and 18 in the original application in the Reply to Office Action dated April 17, 1998. The April 17, 1998 Reply was submitted in response to the Office Action dated January 21, 1998, in which claims 1-70 were rejected under 35 U.S.C. § 101 as being directed toward non-statutory subject matter.¹ Specifically, the Examiner stated in the Jan. 21, 1998 Office Action that claims 1-70 lacked (1) a physical transformation outside the computer; or (2) practical application within the technical arts. **Notably, no art was cited against Applicant in the January 21, 1998 Office Action.**

MPEP § 1412.02 provides a flowchart entitled “Reissue Recapture – Determining its presence or absence,” (hereinafter “Flowchart”) to aid in the determination of whether a rejection due to impermissible recapture is appropriate. The Flowchart is provided herein for ease of reference.

With reference to the Flowchart, if the broadening reissue is filed within two years of the patent grant, for impermissible recapture to be present there must either be: (1) “In the original application, an amendment was made that narrowed the claims to ***overcome an art rejection of record***”; or (2) “In the original application, an argument or statement was made by applicant that a specific claim limitation ***defined over the art of***

¹ The Jan. 21, 1998 Office Action and April 17, 1998 Reply are attached herein for reference.

record.” Absent these two elements, the Flowchart clearly states “*There is no recapture.*” (Emphasis Added).²

Applicant respectfully submits that the reissue application was filed within two years of the date of issuance of the original application, thus broadening of the claims is permissible under MPEP § 1412.03(IV).

Moreover, as clearly evidenced by the Jan. 21, 1998 Office Action and Apr. 17, 1998 Reply, the Claim Limitation was added to overcome a 35 U.S.C. § 101 rejection, and not to overcome an art rejection of record. Moreover, no statements were made by Applicant that the Claim Limitation was added to define over the art of record. To the contrary, Applicant states in the Apr. 17, 1998 Reply, “Applicants [sic] have amended each of the independent claims to variously recite that the solution is applied as the travel scheme for minimizing travel costs by purchasing travel trips in accordance with such solution. *Thus, the claims are now limited to a practical application within the technological arts.*” (Emphasis Added).

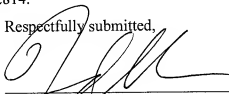
For the reasons provided above, Applicant respectfully submits that the Claim Limitation of “applying the solution as the travel scheme for minimizing travel costs by purchasing travel trips in accordance with the solution” is not surrendered subject matter. Accordingly, Applicant respectfully requests withdrawal of the Section 251 rejection of claims 71-123.

² MPEP § 1412.02 further emphasizes this point. Section 1412.02 states, “If an original patent claim limitation now being omitted or broadened in the present reissue application was originally relied upon by applicant in the original application to make the claims allowable over the art, the omitted limitation relates to subject matter previously surrendered by applicant.” (MPEP § 1412.02(I)(B)(1)(A) (emphasis added)).

Conclusion

Applicant submits that the formal matters related to this application are now in compliance with all statutory requirements. Should the Examiner wish to discuss any of the above in greater detail, then the Examiner is invited to telephone the undersigned at the Examiner's convenience. Applicant authorizes and respectfully requests that any fees due be charged to Deposit Account No. 19-2814.

Respectfully submitted,



Dated: May 15, 2009

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